

REMARKS

Claims 2-6, 50-60, and 70-73 were pending in this application.

Claims 2-6, 50-60, and 70-73 have been rejected.

Claims 2, 50, and 53 have been amended as shown above.

Claims 3, 72, and 73 have been cancelled.

Claims 2, 4-6, 50-60, 70, and 71 remain pending in this application.

Reconsideration and full allowance of Claims 2, 4-6, 50-60, 70, and 71 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 2-4, 50-54, and 70-73 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,339,443 to Lockwood (“*Lockwood*”). The Applicants respectfully traverse this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Lockwood recites a system that facilitates access by multiple processors to shared resources

using multiple registers, including an access request register and an access grant register. (*Abstract*). The registers store an access request semaphore and an access grant semaphore. (*Abstract*). A particular processor requests access to a resource by setting an access request bit in the access request semaphore. (*Col. 2, Lines 64-67*). If and when no lower-priority processors are using the resource and no higher-priority processors have requested the resource, the particular processor sets an access grant bit in the access grant semaphore and gains access to the resource. (*Col. 3, Lines 5-12*).

Claims 2, 50, and 53 have been amended to recite at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” that can be accessed by multiple processors. The Office Action asserts that *Lockwood* discloses these elements at column 5, lines 53-58. (*Office Action, Page 3, Second paragraph*). The portion of *Lockwood* cited by the Office Action fails to anticipate these elements of Claims 2, 50, and 53.

The cited portion of *Lockwood* simply recites that each access grant bit is “unset” by an associated processor after that processor has completed using a resource. (*Col. 5, Lines 53-55*). The cited portion of *Lockwood* also simply recites that each access request bit is “unset” by an associated processor after that processor has unset the access grant bit. (*Col. 5, Lines 55-58*).

This portion of *Lockwood* in no way anticipates “enabling” a resource using an access request bit or an access grant bit. Instead, this portion of *Lockwood* deals solely with resetting bits after use of a resource has concluded. As a result, this portion of *Lockwood* fails to anticipate at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” as recited in Claims 2, 50, and 53.

For these reasons, the cited portion of *Lockwood* fails to anticipate the Applicants' invention as recited in Claims 2, 50, and 53 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 2, 4, 50-54, 70, and 71.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 2-6, 50-60, 72, and 73 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,098 to Ku ("*Ku*") in view of U.S. Patent No. 5,214,778 to Glider et al. ("*Glider*"). The Office Action rejects Claims 2-6, 50-60, and 70-73 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0129184 to Watanabe ("*Watanabe*") in view of *Glider*. The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Regarding the proposed *Ku-Glider* combination, Claims 2, 50, and 53 have been amended to recite at least one "access block bit" that is capable of "enabling" at least one of two or more "modules" (as previously recited in Claims 3, 72, and 73). In rejecting Claims 3, 72, and 73, the Office Action asserts that these elements are disclosed in *Ku*. (*Office Action*, Page 5, *Second paragraph*). However, the Office Action never actually attempts to establish that *Ku* discloses, teaches, or suggests at least one "access block bit" that is capable of "enabling" at least one of two or more "modules." Rather, the Office Action cites two portions of *Ku* as allegedly disclosing elements

recited in Claims 51 and 52, without citing any portion of *Ku* disclosing the use of access block bits capable of “enabling” at least one of two or more “modules.”

Also, the Office Action later acknowledges that *Ku* fails to disclose the use of “at least one access block bit.” (*Office Action, Page 7, Third paragraph*). If *Ku* fails to disclose the use of “at least one access block bit,” *Ku* cannot disclose at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” as recited in Claims 2, 50, and 53.

In addition, the Office Action cites a single portion of *Glider* as disclosing the use of “at least one access block bit.” The cited portion of *Glider* simply recites the use of semaphores. The cited portion of *Glider* lacks any mention of at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” as recited in Claims 2, 50, and 53.

For these reasons, the Office Action has not established that the proposed *Ku-Glider* combination discloses, teaches, or suggests all elements of Claims 2, 50, and 53 (and their dependent claims).

Regarding the proposed *Watanabe-Glider* combination, the Applicants once again note that Claims 2, 50, and 53 have been amended to recite at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” (as previously recited in Claims 3, 72, and 73). In rejecting Claims 3, 72, and 73, the Office Action asserts that these elements are disclosed in *Watanabe*. (*Office Action, Page 8, Last paragraph*). Once again, the Office Action never actually attempts to establish that *Watanabe* discloses, teaches, or suggests at least one “access block bit” that is capable of “enabling” at least one of two or more “modules.” Rather, the Office Action cites

various portions of *Watanabe* as allegedly disclosing elements recited in Claim 2, without citing any portion of *Watanabe* that discloses the use of access block bits capable of “enabling” at least one of two or more “modules.”

Also, the Office Action later acknowledges that *Watanabe* fails to disclose the use of “at least one access block bit.” (*Office Action, Page 11, First paragraph*). If *Watanabe* fails to disclose the use of “at least one access block bit,” *Watanabe* cannot disclose at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” as recited in Claims 2, 50, and 53.

In addition, as shown above, the cited portion of *Glider* lacks any mention of at least one “access block bit” that is capable of “enabling” at least one of two or more “modules” as recited in Claims 2, 50, and 53.

For these reasons, the Office Action has not established that the proposed *Watanabe-Glider* combination discloses, teaches, or suggests all elements of Claims 2, 50, and 53 (and their dependent claims).

Because of this, the Office Action has not established a *prima facie* case of obviousness against Claims 2, 50, and 53 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 2, 4-6, 50-60, 70, and 71.

III. CONCLUSION

As a result of the foregoing, the Applicants assert that all claims in this application are in condition for allowance and respectfully request allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date:

Jan. 5, 2005

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